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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/090,067	06/03/1998	JAMES D. REDMOND	NIS0007	3497

23735 7590 12/02/2003

DIGIMARC CORPORATION
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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/090,067

Applicant(s)

REDMOND ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-16,18-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16,18-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 3-5, 11, 14, 15, 21, 23-26 have been amended for further examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 1, 3-6, 8-11, 13-16, 18-20 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "the viewing party" in line 15. There is insufficient antecedent basis for this limitation in the claim.
4. In Claim 1, it is also not understood what is meant by "the viewing party knows the second confidential location and views said second printed matter is viewed..." as stated in line 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-6, 8-11, 13-16, 18-21 and 23-26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent (GB-2159461A) in view of Dow (1,428,278) and further in view of Richardson (4,239,261).

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UK Patent '461 discloses a document and method for manufacturing tamper-resistant identification cards comprising first printed matter (not seen, but mentioned in Col 2, lines 120-125) at a first location and a first scale, wherein the first printed matter is viewable by a person without magnification; a second printed matter (3) representing the first printed matter rendered at a second scale and location and in a second color, wherein the second scale (micro print) being significantly smaller than the first scale rendering the second printed matter not ascertainable (Col. 2, lines 125-129) by the naked eye under during normal use, but can be viewed by a projector; and wherein the second location being spaced from the first location; and wherein the first and second printed matter conveys identifying information and is specific to the identified person (Col. 2, lines 107-115 and 120-123).

Patent '461 further discloses a method of printing a document which is inherently taught.

However, UK Patent '461 does not disclose minimal contrast hiding printed matter from the naked eye wherein the printed matter and a background color are printed in various hues; wherein the second printed matter conveys the same identifying information as the first printed matter, wherein the second printed is placed at a second secret or confidential location spaced from the first location; wherein the second printed matter is unresolved unless the viewing person knows the second confidential location and wherein second printed matter is viewed using a magnification lens; a plurality of identification documents.

Dow discloses in Fig. 2 and 3, a document comprising printed matter in a first color and the background printed matter in a second color, wherein there is minimal contrast hiding between

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the printed matter and its immediate background which makes its existence hidden from the naked eye. (Col. 1, lines 41-51, and Col. 2, lines 63-71).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify UK Patent '461 document to include minimal contrast hiding between two colors as taught by Dow for the purpose of preventing the document from being counterfeited.

However, UK Patent "461 as modified by Dow does not disclose wherein the second printed matter is placed at a second confidential location spaced from the first location; wherein the second printed matter is unresolved unless the viewing person knows the second confidential location and wherein second printed matter is viewed using a magnification lens; a plurality of identification documents.

Richardson discloses in the Fig. 1, 2, a substrate having printed matter markers placed at different confidential locations (Col. 9, lines 12-38) and at different scale sizes (Col. 7, lines 25-29), wherein the printed matter is unresolved unless the viewing person knows the second confidential location (through the use of a fluorescent substance which can be exposed with a specialized light source (Col. 9, lines 20-28)), and wherein the printed matter is also viewed using a magnification lens (Col. 9, lines 24-29).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify UK's and Dow's document with printed matter which is placed at confidential locations and can only be unresolved with the viewing person knowing where the

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printed matter location and using of a magnifying lens to examine the printed matter as taught by Richardson for the purpose of providing a document or substrate used for covert purposes..

In regards to **Claim 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct any desirable amount of identification documents, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 18-20**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desired indicia for the first and second printed matter, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. In regards to the first printed matter being the same identifying information as the second printed matter, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re*

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Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the second matter is capable of being a copy of the first printed matter.

Response to Arguments

6. Applicant's arguments filed on June 5, 2002 have been fully considered but they are not persuasive.

In response to applicant's arguments that the prior art does not teach the that the second printed matter is located and arranged at a second secret or confidential location, the examiner submits that the Richardson reference is cited in combination with the other prior art to disclose of printed matter arranged at a confidential location.

In response to applicant's argument that the Dow reference does not teach the "use of a combination or printing information at a second scale and using minimal contrast as a way to further conceal its specifically colored security information", the examiner submits that the UK reference is relied upon for disclosing the use of printing information at a second scale to conceal the second printed matter information. The UK reference also discloses that the second printed matter is in a second color. The Dow reference is relied upon for disclosing color variation between a first and second printed matter wherein there is minimal contrast between the two colors. Therefore, it would have been obvious to one having ordinary skill in the art at the time

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the invention was made to modify UK Patent '461 document to include minimal contrast hiding between two colors as taught by Dow for the purpose of preventing the document from being counterfeited.

Conclusion

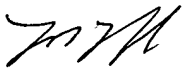
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 24, 2003



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